

REMARKS

Applicants appreciate the thoroughness with which the Examiner has examined the above-identified application. Reconsideration is requested in view of the amendments above and the remarks below.

Rejection under 35 USC § 112, first paragraph

Claims 2-9 stand rejected under 35 USC § 112, first paragraph, for non-enablement. Specifically, the Examiner has stated that, in claim 2, the percentages of the LaSrMnO_3 , + YSZ mixture adds up to more than 100%.

In the "mixing" step of claim 2, the phrase "10 to 30 wt% mixed powder of LaSrMnO_3 and 20 to 50 wt% YSZ" is meant to refer to 10 to 30 wt% of the total mixture of (LaSrMnO_3 and 20 to 50 wt% YSZ). This is supported by the discussion in the specification at page 22, beginning at line 11, wherein it is stated:

LaSrMnO_3 powder, mixed powder of LaSrMnO_3 and 20 to 50 wt% YSZ, and LaSrCoFeO_3 powder are used as a starting material to form an air electrode slurry. Each powder is mixed with 50 to 75 wt% organic solvent and 5 to 40 wt% additive"

In other words, there are three (3) components for each slurry mixture. In the second slurry mixture they are: A) a mixed powder of LaSrMnO_3 and 20 to 50 wt% YSZ, B) organic solvent and C) additive, so that the recited formula is 10 to 30 wt% of (A), 50 to 75 wt% of (b) and 5 to 40 wt% of (C). As such, the "20 to 50 wt% YSZ" in the "mixing" step is not meant to be added again as a fourth component.

So that there is no confusion, the step of "preparing" the mixed powder of LaSrMnO_3 and 20 to 50 wt% YSZ has been separately stated, so that it can be subsequently referred to in the "mixing" and "sequentially coating" steps simply as "mixed powder of LaSrMnO_3 and YSZ." No new matter has been added.

In view of the above, applicants submit that the rejection of claims 2-9 under 35 USC § 112, first paragraph, is now obviated.

Rejection under 35 USC § 103

Claims 2-9 stand rejected under 35 USC § 103 as being obvious from the publication "Fabrication and Characteristics of Anode-Supported Flat-Tube Solid Oxide Fuel Cell," by Kim et al., *Journal of Power Sources*, published May 7, 2003 (the "Kim et al. Publication"), in view of Pham U.S. Patent Publication No. 2005/0037252, Singh U.S. Patent No. 5,516,597 and Kotchick U.S. Patent No. 4,913,982. Applicants respectfully traverse this rejection.

The Kim et al. Publication was co-authored by the three named inventors of the present application, R. Song, D. Shin and J. Kim, along with three other individuals, K. Song, S. Hyun and H. Yokokawa. The latter three additional authors did not invent the subject matter in the Kim et al. Publication that is being cited against the present application - they are listed as co-authors for contributions to the publication other than the cited disclosure. The declaration dated April 6, 2007 that was submitted by the three named inventors of the present application was an uncontradicted "unequivocal statement" regarding the inventorship of the subject matter disclosed in the Kim et al. Publication, and therefore should have been accepted as establishing inventorship thereof under MPEP § 716.10.

Notwithstanding this declaration, the Examiner has cited MPEP § 715.01(c) for its statement that a declaration is "sufficient" if it states that a co-author was working under the inventor's direction. While this rule makes reference to what is "sufficient," it does not make this requirement necessary, and applicants believe that their

uncontradicted "unequivocal statement" in the earlier declaration satisfied MPEP § 716.10 and any requirements to remove the Kim et al. Publication as a reference.

Nevertheless, applicants are enclosing a second declaration under 37 CFR § 1.132 by the co-inventors R. Song, D. Shin and J. Kim attesting to the fact that they are the actual co-inventors of the invention of the present application, and that they invented the subject matter in the Kim et al. Publication that is common to the subject matter disclosed and claimed in the above-identified application.

Additionally, in the second declaration the co-inventors R. Song, D. Shin and J. Kim state that the additional co-authors of the Kim et al. Publication, K. Song, S. Hyun and H. Yokokawa: 1) are not co-inventors of the claimed subject matter of the present application, 2) worked at the direction of the co-inventors with respect to the subject matter in the Kim et al. Publication that is common to the subject matter disclosed and claimed in the above-identified application, and 3) are listed as co-authors for contributions to the Kim et al. Publication other than the subject matter disclosed and claimed in the above-identified application.

In view of the enclosed declaration that establishes that the common subject matter of the cited reference is by the same inventive entity as the instant application, applicants respectfully submit that the Kim et al. Publication is not properly a reference against the instant application under 35 USC §§ 102 or 103. MPEP §§ 715.01(c) and 716.10, *In re Katz*, 687 F.2d 450, 215, USPQ 14, 18 (CCPA 1982).

Since the Kim et al. Publication is the primary reference cited against claims 2-9, and since the remaining references Pham, Singh and Kotchick do not render the subject matter of claims 2-9 obvious to one of ordinary skill in the art, applicants submit that claims 2-9 are patentable under 35 USC § 103.

It is respectfully submitted that the application has now been brought into a condition where allowance of the entire case is proper. Reconsideration and issuance of a notice of allowance are respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter W. Peterson', written over a horizontal line.

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